



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,162	11/10/2000	Guillermo J. Tearney	187718/US - 475387-00245	3219
30873	7590	04/26/2011		
DORSEY & WHITNEY LLP - NEW YORK (PT/18)				
ATTENTION: INTELLECUAL PROPERTY/PATENT DEPARTMENT				
250 PARK AVENUE				
NEW YORK, NY 10177-1500				
EXAMINER				
KISH, JAMES M				
ART UNIT		PAPER NUMBER		
3737				
NOTIFICATION DATE		DELIVERY MODE		
04/26/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[ny.patent.docketing@dorsey.com](mailto:ny.patent.docketing@dorsey.com)  
[hollingsworth.miesha@dorsey.com](mailto:hollingsworth.miesha@dorsey.com)  
[weiss.david@dorsey.com](mailto:weiss.david@dorsey.com)

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/709,162

**Applicant(s)**

TEARNEY ET AL.

**Examiner**

JAMES KISH

**Art Unit**

3737

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 April 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 142-146.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 68, 70-72, 74, 76-82, 84-94, 96-102, 104-141, 147-148, 150-154, 156-157 and 159-162.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/BRIAN CASLER/  
Supervisory Patent Examiner, Art Unit 3737

/James Kish/  
Examiner, Art Unit 3737

Continuation of 11, does NOT place the application in condition for allowance because: As discussed a phone conversation between the Examiner and the Applicant's representative, the finality of the previous Office Action is not being withdrawn at this time. The claims already stated an image-forming lens arrangement. The amended claims further state, "wherein the image-forming lens arrangement forms an image of the anatomical structure." It is inherent that an image-forming lens arrangement would form an image. Furthermore, based on the preamble, it would be inherently an image of the structure for which information is being obtained. The Kittrell Patent discloses a device for forming an image (see the Abstract) and this device utilized lenses and (optionally) a prism. Therefore, a broad interpretation of the claim language is taught by Kittrell in that Kittrell utilizes lenses with the ultimate purpose of forming an image, therefore, an image-forming lens arrangement. As such, the scope of the claimed invention has not changed by the amendments. Therefore, the finality is proper and being maintained. The Examiner notes that there is no portion of the specification that specifically defines an "image-forming lens arrangement" as narrowly as is currently being argued. As such, a broad interpretation is being applied. Beginning at line 5 on page 35, the Applicant again states that "it appears that the Examiner equates the spectral analyzer with the dispersive arrangement." This has been previously addressed and the Examiner urges the Applicant to review the previously stated rebuttal argument (see the bottom of page 2 of the latest Final Office Action). On page 36, the paragraph beginning "Second, as previously stated..." The Applicant argues that there is a claimed order by which the lens arrangement and dispersive arrangement lie within the device. The Examiner disagrees with this and notes that Kittrell teaches both stated portions within its one device (a lens arrangement and a dispersive arrangement) and that there is no claimed order in the current claim language. Both arrangements within Kittrell provide for forwarding one and the same electromagnetic radiation therethrough, as is claimed. Contrary to the Applicant's statement on page 37, the Examiner did not agree that Kittrell lacks the three bulleted items (see the Examiner Interview Summary dated 2/22/11). The Examiner stated in the interview that these three aspects of claimset would be a good direction to go with regard to amending the claims so as to more clearly define what the system is - that is, an endoscopic system. Otherwise the system as claimed comprises a lens and a prism (in its most broad interpretation) and the system would be satisfied by a human holding both a lens and a prism in the air so that light may pass therethrough. Therefore, the Examiner stated that incorporating claims 69, 73 and 75 provide for the other aspects of an endoscopic system (i.e., a light source that illuminates the object with the electromagnetic radiation, an optical fiber to provide the electromagnetic radiation from the source to the target being imaged, and an imager that receives the returned light). The Examiner certainly did not agree that these are lacking in Kittrell. In Figure 21 of Kittrell, an optical waveguide is labeled as 20, and a further arrangement which is structured to obtain the information is labeled as the 60. Furthermore, the spectrum obtained may be displayed to the user on spectral display 86 of Figure 23, which is at least a two-dimensional "image." Also, Kittrell teaches that "Light from conventional sources may be used broadband, or it may be filtered or dispersed (column 20, lines 59-62)" - see page 5 of the latest Final Office Action. Regarding claim 147, the shield acting as a lens is the lens to which this claims reference is being interpreted. Clearly, the light passes through the optical fiber, eventually through the shield which is "at a position of an image plane of the at least one portion which is established by the lens." Therefore, Kittrell teaches the subject matter of claim 147..